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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,113	02/07/2001	Yohan R. Jayaratne	R119-E	5692

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,113

Applicant(s)

JAYARATNE, YOHAN R.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 13-21 is/are allowed.
6) ☒ Claim(s) 1-7, 10, 11 and 22-40 is/are rejected.
7) ☒ Claim(s) 8, 9 and 12 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/03.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement is made of the receipt of the amendment received on 8/21/03. Claims 1-40 are currently pending.

Claim Objections

1. Claims 1, 13, 18-20, 24, 32, 33, 37, and 39 are objected to because of the following informalities:

in claim 1, line 14, substitute “the” with --a--;

in claim 1, line 16, delete “the live person”;

in claim 13, line 1, substitute “the” with --an--;

in claim 13, line 2, substitute the first occurrence of “the” with --a--;

in claim 13, line 19, substitute “the” with --a--;

in claim 18, line 11, delete “the person of”;

in claim 19, line 1, substitute “the” with --an--;

in claim 19, line 2, substitute “the” with --an--;

in claim 20, line 14, delete “the person of”;

in claim 24, line 1, substitute “the” with --an--;

in claim 24, line 2, substitute the first occurrence of “the” with --an--;

in claim 24, line 8, delete “the live person of”;

in claim 24, line 16, delete “the live person of”;

in claim 32, line 1, substitute “the” with --an--;

in claim 32, line 2, substitute the first occurrence of “the” with --an--;

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- in claim 33, line 5, delete “the live person of”;
- in claim 37, line 1, substitute “the” with --an--;
- in claim 37, line 2, substitute “the” with --an--;
- in claim 37, line 9, delete “the person of “;
- in claim 37, line 15, delete “the live person of”;
- in claim 39, line 1, substitute “the” with --an--; and
- in claim 39, line 2, substitute “the” with --an--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 19, 21, and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. What exactly is a “DeLand enabled scanner/card reader”?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 10, 11, and 22-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman (US 4,568,936) in view of Indeck et al. (US 5,546,462) (hereinafter referred to as 'Indeck').

Goldman teaches a card C carrying print 16 indicating the name of the assigned card holder along with a photographic likeness 17, and a magnetic stripe 18 onto which is recorded uniqueness characteristic of the card C from data locations D1, D2, D3, and D4 and statistical data SD representing the birthdate of the assigned card holder (col. 3, lines 14-18; col. 4, lines 4-10; and col. 5, lines 18-60).

Goldman lacks the teaching of the second reference data element representative of a biometric aspect of the card holder and the teaching of the digital data storage medium being a magnetic stripe.

Indeck teaches the use of a secondary security check in the form of a human fingerprint (col. 8, lines 30-35). Also taught is the recording of the magnetic "fingerprint" at a specific region 40 of a thin film magnetic medium 42 (col. 9, lines 52-57).

One of ordinary skill in the art would have readily recognized that encoding the uniqueness of the magnetic stripe itself onto the magnetic stripe would have been advantageous since, in this manner, the uniqueness characteristic does not have to be based upon some other region of the card and can therefore minimize the steps needed for the security process. Furthermore, utilizing a biometric aspect to be stored on the magnetic stripe would have been beneficial for providing unique and distinctive identification of the card holder. Therefore, it

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would have been obvious, at the time the invention was made, to modify the teachings of Goldman with the aforementioned teaching of Indeck.

Allowable Subject Matter

5. Claims 8, 9, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 13-21 are allowable over the prior art.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest either alone or in combination thereof, a method for verifying the authenticity of a mag-stripe card and verifying the identity of the card user presenting the card at a transaction site, the mag-stripe card having a card surface with visually readable indicia indicative of an authorized user of the card and an electronically readable digital data storage magnetic stripe permanently affixed to the card, the method comprising the steps of: deriving a third reference data element representative of a scanned image of the visually readable indicia. Furthermore, no motivation is found to combine any of the references of record to arrive at the claimed invention.

Response to Arguments

8. Applicant's arguments filed 8/21/03 have been fully considered but they are not persuasive.

9. In response to applicant's arguments against the references individually, particularly the Indeck reference, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Indeck reference is replied upon as a secondary reference in view of the primary Goldman reference. The applicant's arguments including "Indeck nowhere teaches nor suggests that a human fingerprint or other biometric aspect of the card user be recorded in digitally readable form on the magnetic stripe of the card along with other card uniqueness data" is moot since the aforementioned elements are taught by the Goldman reference.

Upon further consideration, the examiner submits that claims 22 and 23, previously indicated as allowable in the office action of paper no. 6, are now rejected. Any inconvenience on the part of the applicant is respectfully regretted.

Regarding the use of "DeLand-enabled" in the claims, the examiner's rejection stands. The reference to the DeLand patent in the claims is unacceptable. Instead, the examiner suggests the substitution of "DeLand-enabled" with claim language disclosing the claimed DeLand scanner.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Smith (US 6,012,636) teaches a multiple card data system having first and second memory elements including magnetic strip and fingerprints scanning means.

Ward (US 5,760,386) teaches recording or images.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamara A. Franklin
Examiner
Art Unit 2876

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